REMARKS

I. Introduction

In response to the Office Action dated March 18, 2004, claims 56-62 have been added. Claims 1-62 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Examiner Interview Summary

Record is made of a telephone interview between Applicants' attorney Jason S. Feldmar and Examiner Dharia on March 26, 2004 and March 29, 2004 in connection with the present patent application. Applicants' attorney indicated an issue with respect to the dates of the cited reference and requested a copy of the relied upon provisional application for the Barnard reference. The Examiner agreed to fax a copy of provisional application to Applicants.

III. Abstract

The Office Action rejected the abstract for exceeding 150 words and indicated that the bottom of the abstract was stamped with blue ink. Applicants note that the application was filed on July 31, 2000. Further, the federal regulations that reduced the size of the abstract from 250 words to 150 words was effective on November 7, 2000. Since the present application and abstract were filed prior to the effective date of rule 37 CFR 1.72(b), the 150 word requirement does not apply.

Nonetheless, to expedite examination, Applicants have amended the abstract such that it is within the 150 word requirement.

IV. Prior Art Rejections

In paragraphs (4)-(5) of the Office Action, claims 1-37 were rejected under 35 U.S.C. §102(e) as being anticipated by Barnard, U.S. Patent No. 6,456,938 B1 (Barnard). In paragraphs (6)-(7) of the Office Action, claims 38-55 were rejected under 35 U.S.C. §103(a) as being unpatentable over Neal, U.S. Patent No. 6,192,518 B1 (Neal) in view of Barnard.

Applicants respectfully traverse these rejections.

Specifically, the independent claims were rejected as follows:

Regarding Claim 1, Bernard teaches a system for processing markup data for a map (Col. 15, Lines 39-47) on a personal digital assistant (Col. 19, Lines 4-7) comprising: (a) a personal digital assistant (Col. 19, Lines 4-7); (b) an application on the personal digital assistant (Col. 15, Lines 39-47, Col. 19, Lines 4-7), the application configured to: (i) obtain a map as an encoded (Col. 42, Line 58 to Col. 43, Line 5) and spatially indexed vector representation of geographic data from a server (Col. 14, Lines 47-64); (ii) display the map on a screen of the personal digital assistant (Col. 15, Lines 39-42, Col. 19, Lines 4-12); (iii) obtain markup data (Col. 15, Lines 34-47) comprised of pixel data (Col. 12, Lines 37-39) from a user that utilizes a stylus to markup the map displayed on the personal digital assistant (Col. 13, Lines 33-41); (iv) create a file (Col. 18, lines 14-18) comprised of the markup data (Col. 21, Lines 3-63); (v) upload the file of markup data from the personal digital assistant to the server (Col. 36, Lines 33-42).

Regarding Claim 2, Barnard teaches a system for processing markup data for a map (Col. 15, Lines 39-47) (a) a personal digital assistant (Col. 19, Lines 4-7); and (b) an application on the personal digital assistant (Col. 13, Lines 33-41), the application configured to: (i) obtain a file comprised of markup data for a map (Col. 18, Lines 14-18, Col. 21, Lines 3-63); and (ii) upload the file to a server (Col. 36, Lines 33-42).

Regarding Claim 13, Barnard teaches a system for processing mark up data for a map comprising a server (Col. 17, Lines 31-65) configured to: (a) obtain a file comprised of markup data for a map (Col. 20, Lines 11-15); (b) convert the markup data to coordinate data (Col. 13, Lines 3-16, Col. 15, Lines 45-47, Lines 56-59); and (c) use the coordinate data to obtain a standard data format (SDF) file that can be used to superimpose the markup data on the map (Col. 17, Lines 57-61).

Regarding Claim 15, Barnard teaches a graphical user interface for obtaining redline markup data (Col. 13, Lines 34-41); for a map on a personal digital assistant (Col. 12, Lines 15-25) the graphical user interface (Col. 6, lines 34-42) comprising: (a) determine when a new redline object has been selected (Col. 13, Lines 34-41); and (b) obtain a redline object while a stylus remains in contact with a screen of the personal digital assistant (Col. 13, Lines 49-52, Col. 13, Lines 34-41, Col. 14, Lines 9-11).

Regarding Claim 18, Barnard teaches a graphical user interface for obtaining redline markup data (Col. 13, Lines 34-41); for a map on a personal digital assistant (Col. 12, Lines 15-25) the graphical user interface (Col. 6, lines 34-42) comprising: (a) determine when a new note object has been selected (Col. 20, Lines 56-58, Col. 21, Lines 48-55); (b) accept a user selection of; an anchor point in a display of a map on the personal digital assistant (Col. 21, Lines 55-60); (c) display a text entry screen on the personal digital assistant (Col. 20, Lines 56-60, Col. 21, Lines 53-67, Col. 22, Lines 2-5); (d) accept text user input in the text entry screen (Col. 21, lines 65-67); and (e) display an icon representative of a note at the anchor point (Col. 21, Lines 65-67, Col. 22, Lines 2-5).

Applicants traverse the above rejections for one or more of the following reasons:

(1) The prioirty date of Barnard cannot be relied upon for priority purposes;

(2) Neither Barnard nor Neal teach, disclose or suggest an encoded and spatially indexed vector representation of geographic data;

(3) Neither Barnard nor Neal teach, disclose or suggest obtaining markup data, creating a file comprised of the markup data, and uploading the markup data from a PDA to a server;

(4) Neither Barnard nor Neal teach, disclose or suggest a server converting markup data to coordinate data;

(5) Neither Barnard nor Neal teach, disclose or suggest an SDF file;

(6) Neither Barnard nor Neal teach, disclose or suggest superimposing markup data on a map;

(7) Neither Barnard nor Neal teach, disclose or suggest a redline object; and

(8) Neither Barnard nor Neal teach, disclose or suggest displaying an icon representative of a note at an anchor point selected by a user.

Independent Claim 1

Independent claims 1 provides a system for processing markup data for a map on a PDA. Specifically, an application on a PDA is configured with various functions. The application first obtains a map as an encoded and spatially indexed vector representation of geographic data from a server. The map is displayed on the screen of the PDA. The user then marks up the map with a stylus. A file is then created that is comprised of the markup data. The file is then uploaded from the PDA to the server.

The cited references do not teach nor suggest these various elements of Applicants' independent claims. In addition, priority date of Barnard cannot be relied upon for priority purposes.

Applicants submit that Barnard does not qualify as prior art with respect to the present invention. Specifically, the present invention was filed on July 31, 2000 and claims priority to various provisional applications filed on October 12, 1999 and March 29, 2000. However, Barnard was merely filed on July 21, 2000 and claims priority to a provisional application filed on July 23, 1999. Thus, while Barnard's provisional date beats the filing and priority dates of the present application, Barnard's actual filing date fails to beat the provisional based priority dates of the present invention. In this regard, Applicants submit that they are entitled to the priority dates based on the claim language and support under 35 USC 112 found in the provisional applications relied upon. Accordingly, the question arises as to whether Barnard's provisional date may be used to establish priority over the present invention.

To rely on a provisional filing date to beat the date of the present invention, two conditions must be satisfied: (1) the subject matter of the claim in the issued patent must be supported in accordance with 35 U.S.C 112, first paragraph, in the earlier filed application, and (2) the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e). (See MPEP 201.11 and MPEP 706.02(f)(1); *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978); *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997); and *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002)).

It is clearly apparent that Barnard fails to meet the above two standards. For example, in rejecting claim 1, the Office Action relies on col. 42, lines 58 through col. 43, line 5 of Barnard to teach the claimed element of "encoded". Col. 42, lines 58 through col. 43, line 5 of Barnard is a portion of claim 44 of Barnard. The claims of Barnard are the only area of Barnard that utilize the term "encode". For these claims to have priority based on the provisional date, the provisional must support the claims as issued AND the subject matter used in the rejection (i.e., the use and description of the "encoding") must be disclosed in the provisional application. However, upon an examination of Barnard's provisional application (provided by the Examiner), there does not appear to be any use or description of an "encoding" or a process where data is encoded whatsoever. Further, Barnard's provisional application lacks support under 35 USC 112 for a portable information processing and viewing device that has an information processor for the storage, retrieval, and processing of data which encodes information. Applicants were unable to find any reference in Barnard's provisional to an information processor or encoding.

In view of the above, Applicants submit that the subject matter used to reject claim 1 was not disclosed in Barnard's provisional in accordance with 35 USC 112. Further, the subject matter used in the rejection (i.e., claim 44) lacks support under 35 USC 112 in Barnard's provisional application. Accordingly, the relied portion of Barnard cannot be used to reject the claims.

In addition to the above limitations with respect to the use of Barnard's priority date, Applicants submit that Barnard also fails to teach the invention as claimed. Specifically, claim 1 also provides that the map is obtained as an encoded and spatially indexed vector representation of

geographic data. In rejecting this element, the Office Action relies upon col. 14, lines 47-64. However, this portion of Barnard (and the remainder of Barnard) merely describes a vector-map. Mere recital of a vector-based map ignores the specifically claimed terms "spatially indexed". Under MPEP §2142 and 2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." In this regard, the terms "spatially" and "indexed" cannot merely be ignored when rejecting the claims. These terms have specific meanings as set forth in the application. In addition, Barnard completely fails to teach, suggest, or even remotely allude to a spatially indexed vector representation of geographic data. Instead, Barnard merely describes a vector-map with disclosing whether it is or is not spatially indexed. Such a teaching cannot read on the present invention under either 35 USC 102 or 103.

The remainder of claim one provides for obtaining markup data, creating a file comprised of the markup data and uploading the markup data from the PDA to the server. Applicants note that the file comprised of the markup data is clearly distinguishable from the map or geographic data as set forth in the claims. Specifically, the map is obtained as an encoded and spatially indexed vector representation of geographic data from a server. The application on the PDA then creates the file with the markup data. In rejecting these claim elements, the Office Action relies on Barnard col. 18, lines 14-18, col. 21, lines 3-63, and col. 36, lines 33-42. Applicants note that col. 18, lines 14-18 provide for map data files that includes score card data such as hole data and other course data. In this regard, Barnard's map data file contains all of the course data and information for a particular golf course. This concept of a single file for all map data is clearly set forth in Barnard's provisional application on page 37, section 2.3.4. However, Barnard does not teach nor suggest, that there are two separate files for the map data and the markup data (as claimed). The claims provide for creating the file and clearly distinguish between the file containing the markup data and the map data/map set. Further, to more clearly distinguish that separate files are used, new dependent claims 56-62 specify that the files are separate.

Also, as described above, the claims provide that the created file is comprised of the markup data. In rejecting the file comprised of markup data, the Office Action recites col. 21, lines 3-63.

However, Applicants note that nowhere in col. 21, lines 3-63 is there any description of a file whatsoever. Further, there is no creation of a file that is comprised of markup data. Instead, towards the end of col. 21, Barnard merely describes logging GPS locational data at a predetermined rate. Such locational data is not markup data as set forth in Barnard or as set forth in the present claims. Further, logging GPS data is not even remotely equivalent to creating a file (regardless of whether that file is comprised of markup data or not).

In view of the above, Applicants submit that claim 1 is allowable over the cited references. In this regard, various portions of Barnard are not permitted to be relied upon for priority purposes. Further, the teaching of Barnard fails to set forth various elements/limitations of the present claims.

Independent Claim 2

Claim 2 provides for a PDA, obtaining a file comprised of markup data for a map and uploading the file to a server. As set forth above, Barnard completely fails to describe obtaining a file comprised of markup data for a map. Instead, Barnard merely provides for using a single map data file containing vector and attribute data (see page 20, paragraph 2 of the provisional application). Such a teaching is clearly distinguishable from the claimed file, which simply comprises markup data for a map. Further, the new dependent claims specify that the file comprised of the markup data is separate from a file comprising the map.

In view of the above, Applicants submit that claim 2 is allowable over the cited references.

Independent Claim 13

Claim 13 is similar to claims 1 and 2 in that the file comprises markup data for a map. Claim 3 further provides for converting the markup data to coordinate data and using the coordinate data to obtain an SDF file that can be used to superimpose the markup data on the map.

Applicants reassert the arguments above regarding the markup file. In addition, Applicants traverse the rejection of the other elements of claim 13. In rejecting the conversion of the markup data to coordinate data, the Office Action relies on col. 13, lines 3-16, col. 15, lines 45-47 and lines 56-59. Col. 13, lines 3-16 merely provides that when a mapping process is started, the current GPS location of the receiver is logged. Further, as the device moves, the new locations are logged. Such a logging of location is not equivalent to converting markup data to coordinate data.

Firstly, Applicants note that claim 13 is a server system and is not a PDA device. The claim provides a system for processing markup data for a map comprising a server that is configured to perform the various listed functions. Thus, the claim includes a limitation that the system is a server based system. Col. 13, lines 3-16 clearly provide for a mapping process utilizing the portable device of Barnard. In this regard, the device is a client based device that can easily obtain the coordinate information via its GPS system. However, the claims provide for converting markup data (received/obtained e.g., from a PDA device) into coordinate data. Such a server does not have a built in GPS system since it is stationary (nor is there any description of such a GPS system in the present specification). Further, Applicants note that markup data is not equivalent to location data. The two are entirely different concepts that the Office Action is improperly intertwining.

Col. 15, lines 45-47 and 56-59 merely describe that a vector markup language can be used to edit golf course vectors online and that accurate golf course elevation points can be tagged with latitude and longitude coordinates using various techniques such as a GPS system. Again, such a teaching is performed on Barnard's device itself and is not used on a server. Further, the elevation point data is not converted into coordinate data as claimed. Instead, the elevation point data is tagged with latitude and longitude merely by using a GPS system, Laserplane system, etc. (as described in Barnard) (see col. 15, lines 55-col. 16, line 46).

Claim 13 further provides obtaining an SDF file that can be used to superimpose the markup data on the map. Firstly, Applicants note that an SDF file is a particular type of format as set forth in the claims and specification. In this regard, an electronic search of Barnard for the term "SDF" provides no results whatsoever. Without even mentioning the format SDF, Barnard cannot possibly teach or anticipate a claim that obtains an SDF file. Additionally, the file is used to superimpose the markup data on the map. In rejecting this claim element, the Office Action relies on col. 17, lines 57-61, which provides:

> The exchange of user mapped courses will enable multiple user processing and editing to greatly enhance the quality of the maps. Moreover, individual users may add or modify features to existing course maps as they are encountered on a course.

Not one word of this text even remotely refers to, describes, or suggests, implicitly or explicitly, the superimposing of markup data on a map. Instead, the text merely refers to adding or modifying features on a course map as they are encountered on a course. Such editing in

accordance with Barnard may simply open the map and/or features without ever superimposing markup data on the map. Further, an electronic search of Barnard for the terms "super" and "impose" provide no results. Accordingly, Barnard does not and cannot anticipate, teach, suggest, or render obvious claim 13.

Claim 15

Claim 15 provides for obtaining redline markup data on a map. Specifically, a new redline object is selected. Thereafter, a redline object is obtained while a stylus remains in contact with a screen of the PDA. It is well established and set forth in the specification that the redline object is an object comprised of a redline that is used to comment/markup the drawing/map displayed on the PDA. Further, the redline is a zero width vector that mimics ink flowing from a stylus, and an associated text note that pops up as a tooltip when the object is selected (see page 6, lines 7-17).

Such a redline object is not equivalent to the vectors cited in Barnard Specifically, Barnard merely provides for the creation of various vertex points by moving Barnard's device (e.g., a GPS system). Vectors are drawn between the points (see col. 13, lines 3-41). The user can then edit the vertex points using the stylus to drag one vertex location to another vertex location. The vectors/rays between the vertex points are dragged with the dragged vertex point (see col. 13, lines 34-41). Accordingly, instead of marking up a map with a redline (as claimed), Barnard merely allows the user to adjust a vertex attached to a line. Such a teaching does not even remotely suggest the present invention.

In view of the above, Applicants submit that claim 15 is allowable over the cited references.

Claim 18

Claim 18 provides for obtaining a note markup data for a map on a PDA. Specifically, upon selecting a new note object, an anchor point is selected, a text entry screen is used to enter text input, and an icon representative of a note is displayed at the anchor point.

In rejecting this claim, the Office Action recites various portions of cols. 20 and 21. However, Applicants note that nowhere in cols. 20 or 21 is there any suggestion, implicit or explicit, for displaying an icon representative of a note at an anchor point as claimed. To reject this claim element, the Office Action recites col. 21, lines 65-67 and col. 22, lines 2-5 which provide:

> When "Point" is pressed the current location is logged. Immediately following this, the user is prompted for a note to define the point.
> End
> The user should press the End button as she nears the original start point of an area or the end of a line. When "End" is pressed, the user is prompted for a note to be added about that feature.

As set forth in this portion, Barnard merely prompts a user for a note to define a point. There is no icon displayed or indication that a note is associated with a particular attribute or anchor point on the map (as claimed). The claims specifically provide for displaying such an icon. Further, an electronic search of Bernard for the term "icon" provides no results whatsoever. Without even mentioning the word "icon", Bernard cannot possibly teach displaying such an icon at a particular location on a map.

In view of the above, Applicants submit claim 18 is in allowable form.

V. Conclusion

In view of the above, Applicants submit that independent claims 1, 2, 13, 15, and 18 are allowable over the cited references. Independent claims 20, 31, 33, 36, 38, 49, 51, and 54 were rejected on similar grounds. Accordingly, Applicants submit that these independent claims are also in allowable form.

Moreover, the various elements of Applicants' claimed invention together provide operational advantages over Barnard and Neal. In addition, Applicants' invention solves problems not recognized by Barnard and Neal.

Thus, Applicants submit that independent claims 1, 2, 13, 15, 18, 20, 31, 33, 36, 38, 49, 51, and 54 are allowable over Barnard and Neal. Further, dependent claims 3-12, 14, 16-17, 19, 21-30, 32, 34-35, 37, 39-48, 50, 52-53, and 55-62 are submitted to be allowable over Barnard and Neal in the same manner, because they are dependent on independent claims 1, 2, 13, 15, 18, 20, 31, 33, 36, 38, 49, 51, and 54 respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 3-12, 14, 16-17, 19, 21-30, 32, 34-35, 37, 39-48, 50, 52-53, and 55-62 recite additional novel elements not shown by Barnard and Neal.

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

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